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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,171	12/31/2001	Elazar Sonnenschein	0-05-204	4832

7590 01/09/2007
Kevin D. McCarthy
Roach Brown McCarthy & Gruber, P.C.
420 Main Street - 1620 Liberty Building
Buffalo, NY 14202

EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/036,171	SONNENSCHNEIN ET AL.	
	Examiner	Art Unit	
	John P. Leubecker	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-146 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-146 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/4/02, 6/4/02, 9/16/02, 6/12/06</u> | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The abstract of the disclosure is objected to because it should avoid phrases which can be implied, such as "The present invention relates...". Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 75-146 are objected to because of the following informalities:

As to claim 75, lines 3 and 7, "said endoscope" should be ~~endoscopic device~~— (because otherwise it lacks antecedent basis).

As to claim 76, line 4, "the second object" should be ~~the other of the objects~~— (to be consistent with language of claim 75). It is noted that this occurs in other claims (e.g., 82, 89, etc.) and the term "the first object" is also used in certain claims (e.g., 89). Applicant is required to make these terms consistent **throughout all the claims** (it is even possible to amend claim 75 to use "first" and "second" objects).

As to claim 90, last line, "is achieved" should be deleted.

As to claim 97, line 3, "the surface" should be "a surface".

These are merely some examples of objected to language. Applicant is requested to thoroughly review ALL claims and correct ALL issues.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3739

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 75-146 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 75, this claim improperly recites a markush group because it is not worded in the alternative only ("comprising elements chosen from the group consisting of" allows for more than one element of the group to be chosen).

Further as to claim 75, the list of potential alternatives (whether the device measures distance or alignment; whether it uses transducers, reflectors, or both; which arrangement it uses; whether there are one, more than one or an array of transducers; whether the transducers are located on or near the object; etc.) can vary to an extent which makes the scope of the claim confusing.

As to claims 77 and 78, reference to "a reflecting device" is indefinite since it implies that it is in addition to (i.e., separate element) the "reflector" (claim 75) but appears to be referring to such. Also note that other claims, such as claim 91, which depend on claim 77, refer to "reflectors" (which is supported by claim 75 but not claim 77).

As to claim 79, "step reflector" lacks antecedent basis.

As to claim 93, term "reflecting surfaces" lacks antecedent basis.

As to claim 99, terms "stapler anvil unit" and "cartridge unit" lack antecedence.

As to claim 104, this claim refers back to a canceled claim (claim 1). The Examiner will not assume that it was meant to depend from claim 75 since it essentially repeats the structure of claim 75 (and it would not need to if it depended on it). Furthermore, disregarding its defective

Art Unit: 3739

dependency, this claim, as well as many dependent claims, fails to recite any method steps. The language essentially recites that certain structure is “used” but no use steps are provided.

These are merely some examples of indefiniteness. Applicant is requested to thoroughly review ALL claims and correct ALL issue of indefiniteness.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 94 and 95 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claim positively recites a part of the human body. Language such as “adapted to be” (or equivalents) may be used set apart the structure as having the capability of being used with the body. This would overcome this rejection.

6. Claims 104-146 provides for the use of a system of the endoscopic device but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 104-146 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections- Prior Art

7. Because of the ambiguity in the claims, prior art will not be applied at this time. Only references that appear to be relevant to the nature of the device are cited below.

Double Patenting

8. It is noted that there is potentially a double patenting issue with respect to claim 26 of U.S. Pat. 7,156,863. However, no judgment will be made until the ambiguity in the claims is cleared up.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

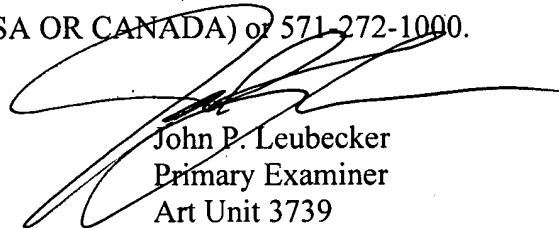
Sonnenchein et al. (U.S. Pat. 7,156,863)	Sonnenschein et al. (U.S. Pat. 6,872,214)
Laufer et al. (U.S. Pat. 6,663,639)	Whitman (U.S. Pat. 6,716,233)
Kortenbach (U.S. Pat. 6,312,437)	El Gazayerli (U.S. Pat. 6,159,146)
Kuramoto et al. (U.S. Pat. 5,395,030)	

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl